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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,511	12/20/2000	Peter Landrock	105005-0044C1	3110
24267	7590	09/08/2005	EXAMINER	
CESARI AND MCKENNA, LLP			RETTA, YEHDEGA	
88 BLACK FALCON AVENUE			ART UNIT	
BOSTON, MA 02210			PAPER NUMBER	

3622

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,511

Applicant(s)

LANDROCK, PETER

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed June 14, 2005. Claims 25-55 and 59-61 have been amended. Claims 25-61 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 33 recites the limitation "encrypting the END and other data with the pre-stored secret key". There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "and using it to encrypt the message comprising the END". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 25-30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Houser et al. (US 5606609).

Regarding claims 25, 28, 33, Houser teaches creating an electronic document (110) and storing in a tamper resistant document hardware (fig. 1), the hardware containing a unique public-secret key pair (see col. 9 lines 36-40); unique document carrier identifier (see col. 12 lines 55-67, Internet address or system identification); signing the unique identifier, the data and the data identifier (serial number), using the secret key of the public-secret key pair and storing the result in the hardware (see col. 5 lines 3-30, col. 9 lines 36-46, col. 11 lines 57 to col. 13 lines 20, col. 14 lines 36-65,

Regarding claims 26, 27, Houser teaches generating a time stamp representing the time of the issue; calculating a hash value of the data and/or the time stamp value and storing the hash value (see col. 19 lines 38-67).

Regarding claim 29, Houser teaches water mark unique to the issuer (see col. 4 lines 47-60, col. 5 lines 50-65, col. 7 lines 44-59).

Regarding claim 30, Houser teaches encrypting the hash value (see col. 13 lines 4-19, col. 14 lines 11-24).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 60 is rejected under 35 U.S.C. 102(a) as being anticipated by BOLERO (see article I "ELECTRONIC DATA INTERCHANGE" UNITED NATIONS COMMISSION ON INTERNATIONAL TRADE LAW, Working Group on Electronic Data Interchange Thirtieth session, Vienna, 26 February – 8, March 1996 and article II, the "REVIEW OF MARITIME TRANSPORT 1998", Chapter VI, Trading Transport Efficiency, UNITED NATIONS, New York and Geneva 1998" article.

Regarding claims 60 and 61, BOLERO teaches electronic negotiating an END sold by seller to a buyer in which the END is negotiated with separately with one or more further buyers, subjected to digital signature (see article I page 21-22, article II page 85-88).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31, 32, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houser in view of Hartman Jr. (US 5,224,166).

Regarding claims 31, 32, 34 and 35, Houser does not explicitly teach encryption status flag, it taught in Hartman (see col. 6 lines 1-8, col. 7 lines 32-53). Hartman teaches status flag indicating whether information is encrypted or not. It would have been obvious to one of

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ordinary skill in the art at the time of the invention to implement Hartman's status flag for the intended use so that the control means is responsive to the state of the flag in performing its function (see col. 8 lines 37-59).

Claims 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable Houser and further in view of Hartman Jr. (US 5,224,166).

Regarding claims 36 and 37, 46-49, Houser teaches encrypting document using public or secret key encryption (see col. 13 lines 4-20). Applicant back ground also teaches that it is well known for data from a seller's document carrier to be encrypted using the public key of the buyer document carrier, transmitted to the buyer, and decrypted using the buyer's secret key (see page 3). Houser does not explicitly teach encryption status flag, it taught in Hartman (see col. 6 lines 1-8, col. 7 lines 32-53). Hartman teaches status flag indicating whether information is encrypted or not. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Hartman's status flag for the intended use so that the control means is responsive to the state of the flag in performing its function (see col. 8 lines 37-59).

Regarding claims 38-45, Houser teaches installing a certificate comprising a digital signature of its unique identifier and of its public key; stored in seller's document carrier; verification of the signature (see col. 7 lines 43-60, col. 13 lines 3-20, col. 14 lines 11-51, col. 15 lines 4-15, col. 14 lines 37-51).

Regarding claims 50 and 51, Houser teaches verifying the data is still valid (see col. 15 lines 54 to col. 16 line 23).

Claims 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable Houser in view of Hartman and further in official notice.

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Regarding claims 52 and 53, Houser does not teach providing the buyer with secret key has been reproduced by issuer or third party. Official notice is taken that is old and well known in the art of crypto to recover a secret key by redistribution. It would have been obvious to one of ordinary skill in art at the time of the invention to reproduce a secret key in order to again provide security.

Regarding claims 54 and 55, Houser does not explicitly teach activating a back-up to recover a lost document. Official Notice is taken that is old and well known in the art at the time of the invention to provide back-up for the intended use of recovering lost document.

Regarding claim 56-59, Houser does not explicitly teach inhibiting the recovery until the expiry of a predetermined period of validity. Official notice is taken that is old and well known in the art of cryptography to check the validity of the encryption key. It would have been obvious to one of ordinary skill in the art at the time of the invention to add such feature for the intended use of insuring that the time interval or period during which the temporary key pair is valid.

Response to Arguments

Applicant's arguments, filed June 14, 2005, with respect to the rejection(s) of claim(s) 25-61 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Houser, Hartman and BOLERO.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR


RETTA YEHDEGA
PRIMARY EXAMINER

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